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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,331	03/16/2004	Lawrence D. Wong	10559-586002	3745
20985	7590	07/16/2007	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				WILSON, SCOTT R
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/802,331	WONG, LAWRENCE D.
	<b>Examiner</b>	<b>Art Unit</b>
	Scott R. Wilson	2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 April 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 10-21 and 23-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10-21 and 23-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 May 2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/27/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2826

## DETAILED ACTION

### *Specification*

Claims 23 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 23 and 24 are word-for-word identical with claims 20 and 21, respectively.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 10-12 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.. As to claim 10, Edelstein et al. discloses (paragraph [0022]) a carbon doped oxide (CDO) film with modulus greater than 15 GPa, which is within the scope of being about 11.5 GPa or greater.

As to claim 11, Edelstein et al. discloses (paragraph [0022]) that the CDO film has a dielectric constant of 3.0.

As to claim 12, Edelstein et al., discloses (paragraph [0022]) a CDO film with modulus greater than about 5 GPa, which is within the scope of being about 11.5 GPa or greater, and a dielectric constant of about 2.5.

As to claim 15, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Art Unit: 2826

As to claim 16, Edelstein et al. discloses (paragraph [0022]) that the CDO film has a modulus greater than 15 GPa, which is within the scope of being in the range of about 20 GPa to about 25 GPa.

As to claim 17, Edelstein et al. discloses (paragraph [0022]) that the CDO film has a dielectric constant of 3.0.

As to claim 18, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Claims 19-21, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.. As to claim 19, Edelstein et al. discloses (paragraph [0071]) a carbon doped oxide (CDO) film with hardness up to 2 GPa, which is in the range of about 1.9 GPa to about 3.5 GPa.

As to claim 20, Edelstein et al. discloses (paragraph [0071]) that the CDO film has dielectric constant of 3.2.

As to claim 21, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

As to claim 23, Edelstein et al. discloses (paragraph [0071]) that the CDO film has dielectric constant of 3.2.

As to claim 24, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.. Edelstein et al. discloses (paragraph [0071]) a carbon doped oxide (CDO) film with hardness up to 2 GPa, which is in the range of about 1.9 GPa to about 3.5 GPa, and a modulus up to about 15 GPa.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2826

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein et al.. Although Edelstein et al. does not expressly disclose the density of the CDO film with modulus greater than 11.5 GPa, such a film would necessarily have a density in the claimed range. See MPEP 2112.01,

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 562 F.2d at 1255, 195 USPQ at 433. See also Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims were directed to a titanium alloy containing 0.2-0.4% Mo and 0.6-0.9% Ni having corrosion resistance. A Russian article disclosed a titanium alloy containing 0.25% Mo and 0.75% Ni **but was silent as to corrosion resistance**. The Federal Circuit held that the claim was anticipated because the percentages of Mo and Ni were squarely within the claimed ranges. The court went on to say that it was immaterial what properties the alloys had or who discovered the properties because the composition is the same and thus must necessarily exhibit the properties.)."

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein et al.. As to claim 26, Edelstein et al. discloses (paragraph [0071]) a range of hardness up to about 2 GPa. Since there are no stated 1-sigma uncertainties, the upper boundary "about 2 GPa" can be considered to be within the claimed range of about 2.8 GPa to about 3.5 GPa. Likewise, Since there are no stated 1-

Art Unit: 2826

sigma uncertainties, the disclosed (paragraph [0071]) upper range of modulus of Edelstein et al., about 15 GPa can also be considered to be within the claimed range of about 20 GPa to about 25 GPa. See MPEP 2144.05 on Obviousness of Ranges,

"In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a **prima facie case of obviousness exists.** In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of "50 to 100 Angstroms" considered **prima facie obvious** in view of prior art reference teaching that "for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms]." The court stated that "by stating that 'suitable protection' is provided if the protective layer is 'about' 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant's] claimed range."). **Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.** Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.)."

As to claim 27, Edelstein et al. discloses (paragraph [0071]) that the dielectric constant of the CDO film is about 3.2.

As to claim 28, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Art Unit: 2826

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott R. Wilson whose telephone number is 571-272-1925. The examiner can normally be reached on M-F 8:30 - 4:30 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Purvis can be reached on 571-272-1236. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

srw

July 9, 2007

  
SUE A. PURVIS  
SUPERVISORY PATENT EXAMINER